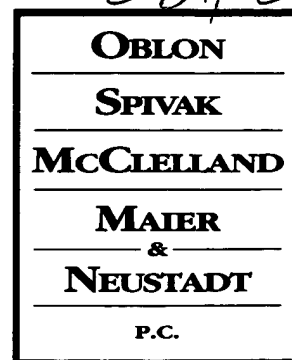




Docket No.: 0557-4969-2



ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

ATTORNEYS AT LAW
GREGORY J. MAIER
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GMAIER@OBLON.COM

RE: Application Serial No.: 09/552,657
Applicants: Tomohiro NAKAJIMA
Filing Date: April 19, 2000
For: MULTIBEAM SCANNING APPARATUS
Group Art Unit: 2872
Examiner: PHAN, J.

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier
Attorney of Record
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Registration No. 28,870



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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

Tomohiro NAKAJIMA

SERIAL NO: 09/552,657

FILED: April 19, 2000

FOR: MULTIBEAM SCANNING
APPARATUS



: GROUP: 2872

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: EXAMINER: PHAN, J.

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PROVISIONAL ELECTION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, DC 20231

SIR:

In response to the Office Action dated July 3, 2001, Applicant provisionally elects for prosecution on the merits Species 1 and identifies Claims 1-4 and 9-17 as readable on the provisionally elected species.

Applicant respectfully traverses the election requirement for several reasons.

First, the outstanding Official Action merely includes the conclusory statement that "This application contains claims directed to ... patentably distinct species" without stating any basis whatsoever in support of such a finding. This is contrary to MPEP §816, which states:

MPEP §816

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. **A mere statement of conclusion is inadequate.** The reasons upon which the conclusion is based should be given.... (Emphasis added)

In view of the “mere statement” that the claims are patentably distinct, it is respectfully submitted that the PTO has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires:

MPEP § 806.04(f)

Claims to be restricted to different species must be mutually exclusive....

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics and this failure provides a further basis for traversing the election requirement.

Finally, MPEP § 803 states:

MPEP § 803

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Accordingly, Applicant also respectfully traverses the outstanding restriction requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, but would place a substantial burden on Applicant to prosecute three separate applications.

In this particular case, since the basis for the election requirement is not clear,

Applicant respectfully requests that the requirement be withdrawn, and that all the claims be examined on the merits in the present application.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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